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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,752	11/21/2003	Ulrich Bohne	2819	3134
7590 12/20/2005 STRIKER, STRIKER & STENBY 103 East Neck Road Huntington, NY 11743			EXAMINER BLAKE, CAROLYN T	
			ART UNIT 3724	PAPER NUMBER

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,752

Applicant(s)

BOHNE ET AL.

Examiner

Carolyn T. Blake

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,7,8,10 and 13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3-5,7,8,10 and 13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on October 13, 2005.
2. The objection to the specification is withdrawn in view of the amendment.
3. The text of those sections in Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Inventorship***

4. 37 CFR 1.48(a) requires a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive invention on his or her part. Consequently, the request to correct inventorship is denied because an original inventor, Heiko Roehm, has not signed a statement.
5. As it appears that a party required by 37 CFR 1.48(a)(2) to submit a statement of facts may not be willing to submit such statement, applicant should consider either: a) submission of a petition under 37 CFR 1.183 to waive that requirement if the original named inventor(s) has assigned the entire right and interest to an assignee who has given its consent to the requested inventorship correction, MPEP § 201.03, Statement of Lack of Deceptive Intention, or b) refiling the application (where addition is needed under 37 CFR 1.53(b) with a new oath or declaration and any necessary petition under 37 CFR 1.47, or where only deletion is needed, either under 37 CFR 1.53(b) utilizing a copy of a prior oath or declaration under 37 CFR 1.63(d)(1)(iv), or under 37 CFR

Art Unit: 3724

1.53(d))(design applications only), thereby eliminating the need for a 37 CFR 1.48 request.

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the air passage being screw-shaped and the structure that allows the outlet pipe to be "formed turnable" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

7. The drawings are objected to because the depiction of the air passage (26) in FIG 3 is not clear. Indication of the air passage on another view or an enlarged view of the passage would ease understanding.

8. The drawings are objected to because they contain text. All text from FIGS 1-3 should be deleted and replaced with appreciate description in the specification.

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 100, 101, 104, 126, 127, and 226.

10. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

Art Unit: 3724

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

11. The disclosure is objected to because of the following:

Page 9, line 14: "another" should be changed to - -other- -.

Appropriate corrections are required.

### ***Claim Objections***

12. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. All the limitations of claim 8 appear to be an exact duplication of limitations found in claim 1.

13. Claim 10 is objected to because it appears to be dependent from claim 61, which does not exist. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

14. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The air passage being screw-shaped is not described in a way as to enable one skilled in the art to make the device as claimed.

15. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The structure which allows the outlet pipe to be formed turnable is not described in a way as to enable one skilled in the art to make the device as claimed.

16. The claims are replete with vague and indefinite language and should be carefully reviewed. The following are examples of many of the occurrences of such language. Applicant is required to review and correct all the pending claims.

17. Claims 1, 3-5, 7, 8, 10, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear how the air passage is screw-shaped.

Regarding claim 4, the outlet pipe does not close the outlet. Rather, the pipe is connected to the outlet.

Art Unit: 3724

Regarding claim 5, it is unclear how the outlet pipe is "formed turnable."

Regarding claim 10, the claim refers to two different inlets, and then "said inlet."

It is unclear which inlet is considered "said inlet."

***Claim Rejections - 35 USC § 102***

18. Claims 1, 3-5, 7, 8, 10, and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Sauer (DE 644,011).

Regarding claims 1 and 8, Sauer discloses an electric hand power tool, comprising a housing (2); a rotatably driven tool (11); a protective hood (13) which at least partially covers said tool (11); a handle (18) and an auxiliary handle (16) for a two-hand guidance of the power tool, said auxiliary handle (16) being hollow and formed as a withdrawal passage for a removed material thrown from the rotatably driven tool (11), said auxiliary handle (16) has an inlet which is formed so that a radiating direction of the removed material from said rotatably driven tool (11) is substantially tangential to a work piece periphery in an inlet of said auxiliary handle (16); and an air cooled-electric motor (1) with drives said tool and is accommodated in said housing (2), said housing (2) having an air passage provided with an air inlet opening (near 17) for a motor spent air, said air passage being screw-shaped in a direction of the motor spent air which is directed in an opposite direction of said rotatably driven tool (11). Based on FIG 1, the air direction and work piece periphery appear to be substantially tangential as claimed. In addition, the air passage curves, and thus can be considered "screw shaped."

Regarding claim 3, Sauer discloses said auxiliary handle (16) has an inlet (14), which is open to an interior of said protective hood (13) and an outlet (15) arranged at or near a handle end facing away from said inlet.

Regarding claim 4, Sauer discloses an outlet pipe which encloses said outlet (15).

Regarding claim 5, Sauer discloses said outlet pipe is formed turnable. The outlet pipe would move in response to movement of the handles, and thus can be considered "formed turnable" to the degree understood.

Regarding claim 7, Sauer discloses an air-cooled electrical motor (1) which drives said tool (11) and is arranged in said housing (2), said housing (2) being formed so that a motor spent air which leaves said air-cooled electric motor (1) flows into said auxiliary handle (16).

Regarding claim 10, Sauer discloses said housing (2) has an air passage provided with an air inlet (near 17) opening for a motor spent air, said air passage expanding toward an inlet of said auxiliary handle (16) and opening into said inlet (near 17). Note the expansion from annular passage 5 toward the reference number "17" in FIG 1.

Regarding claim 13, Sauer discloses said auxiliary handle (16) is formed as a bracket handle and has one handle end which is placed on said protective hood (13) and another handle end with which said bracket handle is fixed at or near a housing part of said housing (2) which accommodates an electric motor (1).



***Response to Arguments***

19. Applicant's arguments filed October 13, 2005 have been fully considered but they are not persuasive. .

Regarding the argument the Sauer handle does not carry dust, the examiner is interpreting the handle 16 to entail the area near reference number 17 to the outlet 15. Applicant argues the Sauer device only removes some material and not all. However, even if this argument were true, this is not claimed.

Regarding the argument Sauer does not disclose a tangential relationship as claimed, the examiner disagrees. Certainly, in any situation concerning a curved surface, an infinite number of tangential lines can be drawn. While Applicant argues one specific tangential line does not meet the claim limitation, several tangential lines could be drawn that do meet the limitation.

Regarding the argument the Sauer air passage is not screw-shaped, the examiner does not understand what is mean by the term "screw shaped." The Sauer air passage can be considered "screw shaped" as claimed. Please see the rejections under 35 USC § 112.

In addition, Applicant points out several differences between the Sauer device and the instant application. However, these differences are not claimed. Furthermore, while the application may contain allowable subject matter, Applicant must address the rejections under 35 USC § 112. Even if the claims are amended to read over the prior art, the application will not be in condition for allowance if these issues are not addressed.

***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 14, 2005



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